

No. 22208

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

EDOCO TECHNICAL PRODUCTS, INC.,

Appellant,

vs.

PETER KILWIT SONS' Co., and THE B. F. GOODRICH
COMPANY,

Appellees.

APPELLEES' BRIEF

and

APPENDIX CONTAINING PORTIONS
OF RECORD ON APPEAL.

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Appellees.

APPELLEES' BRIEF.

Edoco Technical Products, Inc., plaintiff in the District Court, has appealed from a summary judgment in favor of Peter Kiewit Sons' Co., and The B. F. Goodrich Company, defendants below.

The jurisdictional statement and statement of the case contained in appellant's Opening Brief neglects to refer to pages of the record, as required by Rule 18 of this Court, and the statements are otherwise incomplete. For these reasons, appellees find it necessary to submit their own statements, which follow.

Jurisdiction.

Plaintiff-Appellant, Edoco Technical Products, Inc., filed its complaint [R 2]* in the U.S. District Court

*The letter R followed by a number denotes the page in the record on appeal where the item appears.

for the Central District of California, charging defendant Peter Kiewit Sons' Co., one of the appellees, with infringement of U.S. Patent No. 3,023,681 granted March 6, 1962 for Combined Weakened Plane Joint Former and Waterstop. The B. F. Goodrich Company made application to the District Court for leave to intervene as a party defendant [R 33], which was granted [R 112].

Both defendants filed answers to the complaint [Peter Kiewit R 48, B. F. Goodrich R 114], averring invalidity, denying infringement, and charging Edoco with unlawful misuse of the patent. The defendants also counterclaimed for declaratory judgment in accordance with their answers. Edoco replied to the counterclaims [R 99, 124].

Defendants filed a motion for summary judgment on the grounds set up in their respective answers and counterclaims [R 170]. The motion was granted on the ground of non-infringement [R 329, 371]. The District Court made no determination on the issues of validity and misuse of the patent.

The District Court made findings of fact and conclusions of law [R 351, A 4]*. These are not required, Rule 52(a) F.R.C.P., but "when made they are helpful to the appellate court." *Fromberg, Inc. v. Gross Manufacturing Company, Inc.*, 9 Cir., 1964, 328 F.2d 803, 140 U.S.P.Q. 641.

*The letter A followed by a number denotes the page in the Appendix bound with this brief. The District Court's findings and conclusions, memorandum opinions, and summary judgment, are all printed in the Appendix for the convenience of this Court. Also reproduced are Figures 1-4 of the drawing—in the patent in suit, and a defendants' interrogatory exhibit C depicting the accused structure.

The summary judgment [R 369, A 22], entered June 30, 1967, dismissed the complaint and the action on the merits with prejudice, and sustained the counterclaims for declaratory judgments on the ground of non-infringement.

Jurisdiction of the District Court was conferred by 28 U.S.C. §§1338(a) and 1400(b), and 35 U.S.C. §§ 281-285, 28 U.S.C. §2201 and §2202.

Plaintiff appealed July 20, 1967 [R 373]. This Court of Appeals has jurisdiction under 28 U.S.C. §1291.

The summary judgment appealed from disposes of the counterclaims as well as the complaint, and therefore should not be subject to remand as occurred in *Illinois Tool Works v. Brunsing*, 9 Cir., 1967, 378 F.2d 234, 153 U.S.P.Q. 771.

If any question remains as to the finality of the judgment, it is met by the last paragraph therein, conforming to the language approved in the *Illinois Tool* case, stating the express determination of the District Court that there is no just reason for delay and expressly directing the entry of final judgment.

Statement of the Case.

The Patent in Suit.

The patent in suit (Item A in the Book of Patents and File Wrapper, Figs. 1-4 of the drawing at A 24; also a copy is reproduced in Op. Br. 38*) is directed to a paving section which may be concrete, wherein is embedded a fracturing band vertically disposed, and a

*Op. Br. followed by a number denotes the page in Plaintiff-Appellant's Opening Brief to which reference is made.

waterstop horizontally disposed, the two parts being integrally connected together.

The upper portion of the band tapers upwardly for a distance greater than the thickness in the central region of the band, and the lower portion of the band tapers downwardly for a distance greater than the thickness of the central region of the band. Opposite edges of the band are straight.

Preferably, although not necessarily, the band and waterstop are formed of a resilient material, such as a synthetic plastic.

The waterstop comprising the horizontal strips is serrated to define longitudinal ribs, and additionally is provided at its outer edges with enlarged longitudinal anchor elements.

The purpose of the vertical band is to separate the poured concrete along a predetermined relatively straight line for a portion, but not all, of the depth of the concrete, whereby when the concrete cures and contraction occurs, the concrete will tend to crack and separate in or near the vertical plane of the edges of the band. Subsequently, when expansion and contraction occurs, due to changes in temperature, the same lines provide for such, and indiscriminate cracking is minimized, if not prohibited.

The waterstop is to prevent water which seeps through the uppermost crack from making its way to the ground underneath the concrete.

The foregoing description relates to the form of structure illustrated in Figures 1-4 of the patent in suit and is allegedly protected by claims 1 and 2. A sample of plaintiff's fracturing band and waterstop (gray in col-

or), responding to claims 1 and 2, is before the Court as Hearing Exhibit 1. Only claims 1 and 2 are charged to be infringed.

Inasmuch as appellant makes no contention that claim 3 is infringed, and such claim reads only on the form illustrated in Figures 5-8, such figures may be disregarded.

Appellees' Alleged Infringing Acts.

Appellee, Peter Kiewit Sons' Co., performed concrete lining operations in a section of what is known as the San Luis Canal in the general vicinity of Cantua Creek, in the County of Fresno, State of California. Included in the construction of said concrete lining are weakened plane joints, sometimes called contraction joints, comprising polyvinyl chloride strips cruciform in cross section which were inserted in the concrete as it was laid, or soon thereafter, while the concrete was still soft; certain of such strips extend longitudinally of the canal, and other strips extend transversely thereof. The lines represented by these strips generally define approximately 15 ft. squares, although this dimension varies.

Samples of the strips are before this Court as Interrogatory Exhibits. Exhibit A is a sample of blue material, and Exhibit B is a sample of white material. The blue material was laid longitudinally, and the white material was laid transversely. Interrogatory Exhibit C [R 21, A 25] is a drawing in which Figure 1 illustrates the blue material in place in the concrete as laid and before curing. Figure 2 illustrates the same cross section of concrete as Figure 1 after the concrete has cured and contraction lines have appeared. Figure 3 is a fragmentary plan view of a portion of the concrete

lining illustrating 15 ft. squares defined by the contraction lines. Insofar as this case is concerned, there is no distinction between the white and the blue material.

The vertical elements of the strips described, used by Peter Kiewit Sons' Co., are not tapered in either direction but embody flat, parallel outside surfaces. The horizontal waterstop element embodies no serrations, but merely enlarged beads along the outer edges.

Appellee The B. F. Goodrich Company furnished the strip material described above to appellee Peter Kiewit Sons' Co. which the latter used in the canal construction. In furnishing such material to Kiewit, B. F. Goodrich at all times had knowledge of its intended use by Kiewit, and of the manner in which Kiewit used it in the canal construction. The material was especially made and especially adapted for such use by B. F. Goodrich.

Question Presented.

The question expressly* presented by appellant's appeal can be reduced to the following:

Whether the District Court correctly determined that there was no genuine issue of material fact on the question of non-infringement and was justified in disposing of the case on that ground.

*The Court of Appeals may, if it chooses, also consider the question of validity on which, although not decided by the District Court, the record is sufficiently complete to make the finding one of law only. See *M.O.S. Corporation v. John I. Haas Co., Inc.*, C.A. 9, 1967, 375 F.2d 614, 153 U.S.P.Q. 153.

Both questions, and a third one, misuse of the patent, were raised in the District Court, by defendants' motion for summary

The motion was based upon the complaint and the defendants' answers thereto, the plaintiff's several answers to defendants' interrogatories [R 57, 144], a copy of the patent in suit, a copy of the file wrapper and contents of said patent, file wrapper references, copies of additional prior art (Book of Patents and File Wrapper), and various exhibits. Also before the District Court were an affidavit of Lee Worson [R 246] and an affidavit of Francis A. Utecht [R 243].

The District Court filed a memorandum opinion June 7, 1967 [R 329, A 1] stating that "the defendant's motion for summary judgment should be granted upon a consideration of the issue of non-infringement only. As to the question of validity and misuse of the patent, no determination can be made upon a motion for summary judgment as material questions of fact still remain to be resolved.

"The motion for summary judgment, therefore, is granted and defense counsel shall prepare new findings of fact, conclusions of law and judgment in accordance therewith."

Findings and Conclusions were made and filed June 30, 1967 [R 351, A 4], and on the same date the District Court filed another memorandum opinion [R 371, A 2] reaffirming and amplifying the first one.

judgment. We have no authority to support any suggestion that the misuse issue is before this Court in the present posture of the case.

Summary of Argument.

1. The claims of the patent in suit on their face cannot be read on the appellees' structures.

2. The claims of the patent in suit must be construed so narrowly by reason of the file wrapper history that non-infringement is clearly established.

3. The prior art cited by the Patent Office can be readily understood by the Court without the aid of expert testimony, and imposes such restriction in construing the claims that appellees' structures must fall outside the scope thereof.

4. A case for summary judgment was fully established and it was proper for the District Court to dispose of it accordingly.

5. If the Court of Appeals elects to affirm on the ground of invalidity, the record amply sustains such a determination.

ARGUMENT.

I.

The Claims of the Patent in Suit on Their Face Cannot Be Read on Appellees' Structures.

Appellant concedes this. In its Op. Br. 24, is the following language:

“Admittedly patent Claims 1 and 2 are not literally infringed by defendants' structure. This follows since defendants' vertical band is straight sided rather than being tapered, and defendant employs beads on the edges of the horizontal sealing strips, rather than the serrations means recited in the claims.”

Under axiomatic law the patentee is bound by the language he has employed in his claims. This should dispose of the case. Appellant endeavors to hang on by a thread, however, in arguing that the doctrine of equivalents must be considered. We discuss this as a part of the next point.

II.

The Claims of the Patent in Suit Must Be Construed so Narrowly by Reason of the File Wrapper History That Non-Infringement Is Clearly Established.

This subject is treated in detail in appellees' motion for summary judgment [R 170], and is summarized in the findings and conclusions [R 351, A 4], as well as the District Court's memorandum opinion [R 371, A 2].

Claims 1 and 2 are copied here for the Court's convenience, with the limitations italicized which impose the narrow construction.

1. In a paving section, a weakened plane joint, comprising: an elongated vertically extending paving fracturing band of lesser height than the depth of said paving section, *said band having its upper portion tapering upwardly for a distance greater than the thickness of said band to provide a continuous straight edge below the upper surface of said paving section, said band having its lower portion tapering downwardly for a distance greater than the thickness of said band to provide a continuous straight edge disposed above the lower surface of said paving section* whereby said paving section undergoes fracturing in vertical alignment with the upper and lower edges of said band as said paving cures so as to define said weakened plane joint across said paving section; and a horizontally extending sealing strip integrally connected to each side of said band, *said strips each being formed with longitudinally extending serration* means that are firmly embedded within said paving as said paving cures, said sealing strips co-operating with the paving section on either side of said weakened plane joint to restrain the downward flow of water through said joint, said paving fracturing band and said sealing strips being formed of resilient material whereby relative movement is permitted between the portions of said paving section on either side of said weakened plane joint.

2. In a paving section, a weakened plane joint, comprising: an elongated vertically extending pav-

ing fracturing band of hollow, generally bulbular configuration, having a central air space, said band being of lesser height than the depth of said paving section, *said band having its upper portion tapering upwardly for a distance greater than the thickness of said band to provide a continuous straight edge below the upper surface of said paving section, said band having its lower portion tapering downwardly for a distance greater than the thickness of said band to provide a continuous straight edge disposed above the lower surface of said paving section* whereby said paving section undergoes fracturing in vertical alignment with the upper and lower edges of said band as said paving cures so as to define said weakened plane joint across said paving section; and a horizontally extending sealing strip integrally connected to each side of said band, *said strips each being formed with longitudinally extending serration means* that are firmly embedded within said paving as said paving cures, said sealing strips cooperating with the paving section on either side of said weakened plane joint to restrain the downward flow of water through said joint, said paving fracturing band and said sealing strips being formed of resilient material whereby relative movement is permitted between the portions of said paving section on either side of said weakened plane joint.

The factual background for the limitations is manifest and incontestable, and no amount of testimony, expert or otherwise, could change the facts.

Suffice it to say that Dr. Worson, the patentee, presented claims in the application as filed which were

broad enough to read on a structure embodying any cruciform insert to form the weakened plane joint and waterstop [F.W. 12 *et seq.*]*

He was met with art and rejections. He finally acquiesced in the Patent Office examiner's position, and in order to obtain the patent, after two personal interviews of his attorney with the examiner, cancelled all previous claims and submitted the claims which became the three claims of the patent [F.W. 47-49]. Some pertinent details are hereinafter reviewed.

The limitations included in the final set of claims, which rendered them allowable in the opinion of the examiner, specified for the first time in the case that the vertically extending paving fracturing band have "its upper portion tapering upwardly for a distance greater than the thickness of said band to provide a continuous straight edge below the upper surface of said paving section * * *," and "having its lower portion tapering downwardly for a distance greater than the thickness of said band to provide a continuous straight edge disposed above the lower surface of said paving section."

In support of this final set of claims, the attorney appended remarks [F.W. 50-51], which included the following language:

"The courtesy of the Examiner at the recent interview is hereby acknowledged.

At this interview, the desirability of revising the form of the claims so as to patentably distinguish over the prior art was discussed. In accord-

*F.W. followed by a number indicates the page in the Worson File Wrapper to which reference is made.

ance with this discussion, claims 13, 14 and 15 have been cancelled and new claims 16, 17 and 18 substituted therefor.

“The new claims specifically recite the applicant’s paving fracturing band as having an upper portion tapering upwardly for a distance greater than the thickness of the band to provide a continuous straight edge below the upper surface of the paving section. Similarly, the lower portion of the band is recited as tapering downwardly for a distance greater than the thickness of the band to provide a continuous straight edge disposed above the lower surface of the paving section. Because of this configuration, the paving section undergoes fracturing in vertical alignment with the upper and lower edges of the band as the paving cures so as to define a weakened plane joint across the paving section.”

Further, in order to support these claims, and after another discussion of his attorney with the Examiner, Worson inserted in the specification the following language [F.W. 58]:

“The upper portion of band 12 tapers upwardly for a distance greater than the thickness of the band to provide a continuous upper straight edge while the lower portion of the band tapers downwardly for a distance greater than the thickness of the band to provide a continuous straight edge at the lower end of the band.”

This insert is found in the patent at Column 2, lines 43-49.

In view of this prosecution as outlined, the patentee has excluded himself from asserting that the use of a fracturing band which is not tapered falls within the scope of his claims. A band which has parallel surfaces is not tapered.

Absence of Tapers in Band.

It is manifest from the appropriate exhibits and description, as well as admission by appellant, that the accused structures do not include any band having either its upper portion tapering upwardly or its lower portion tapering downwardly. Consequently, these structures are outside the scope of plaintiff's claims and do not infringe claim 1 or claim 2.

Appellant contends that the Worson Affidavit [R 246] and the Utecht Affidavit [R 243] require application of the doctrine of equivalents (Op. Br. 24-36).

The passages in these affidavits relied on by appellant are argumentative rather than factual. Thus Worson asserts that the Kiewit "joint employs each of the elements or their equivalents recited in Claims 1 and 2 of my patent."

Appellant's citation of *Nelson v. Batson*, 9 Cir., 322 F.2d 132 (Op. Br. 24) does nothing to advance its cause. The Court there discusses the principles of the doctrine of equivalents. It agrees with the district court in the case that the invention was a minor improvement in a crowded field, that the range of equivalents to which the inventor was entitled was at best narrow, and that to expand the patent monopoly appreciably be-

yond the precise combination of old elements which he claimed would reward him disproportionately.

Appellant insists that the vertical taper language of the claims is not a proper ground for file wrapper estoppel (limiting equivalency) unless the tapering “language goes to the heart of the invention.” (Op. Br. 21). In support it cites *International Manufacturing Co. v. Landon, Inc.*, 9 Cir., 336 F.2d 723.

Appellant classifies the Worson patent claims as combination claims (Op. Br. 11). There is no legally recognizable or protected “heart” of the invention in a combination patent. *Nelson v. Batson, supra*.

Moreover, in a combination patent, redefinition of an element gives rise to file wrapper estoppel, when “the redefinition was necessary to obtain the patent.” *International Manufacturing Co. v. Landon, supra*, 336 F.2d at page 727.

It cannot be denied that the redefinition of the fracturing band was necessary to obtain the Worson patent. Worson’s attorney did more than change the “form” of the claims (Op. Br. 35). He changed the “substance.”

The patentee thus narrowed his claims in order to escape rejection. “By thus limiting his claims, he is estopped to enlarge them by resort to the doctrine of equivalents. *D & H Electric Co. v. M. Stephens Mfg. Inc.*, 9 Cir., 233 F.2d 879, 883-884.” *Moon v. Cabot Shops, Inc.*, 9 Cir., 270 F.2d 539, 545, 123 U.S.P.Q. 60, 64. Cert. den., 361 U.S. 965, 4 L.ed 2d 546, 80 S.Ct. 596, 124 U.S.P.Q. 535.

**Worson "Invention" a Narrow One in
a Crowded Art.**

Appellant attempts to qualify the Worson "invention" as pioneer in character, *i.e.*, the first to combine a weakened joint strip former and horizontal sealing strips [water stops] (Op. Br. 4, 11). This is the premise for the contention that equivalency brings appellees' structure within the claims (Op. Br. 24).

In support of his contention, appellant redefines the entire Worson "invention" on page 23 of its Opening Brief in the following language (*italics are the appellant's*):

"What was new and what was patented by Worson was the combination of a length of paving in which the fracturing band was correlated with the paving so that the fracturing band not only formed the weakened plane joint but also served as a water-stop in the completed joint."

The quoted language is merely a restatement of the subject matter as defined in the original claims 1-12, and in the substitute claims 13-15.

Claims 1-10 recited "A combined weakened plane joint former and waterstop device." Claim 12 was for a "waterstop device" *per se*. The paving section was not positively recited.

Claims 1-12 were rejected by the Examiner as "unpatentable" over cited prior patents [F.W. 26]. Worson's attorney made a minor amendment to the claims without changing their combination character and argued their allowability [F.W. 27].

The Examiner again rejected the claims as "unpatentable" over prior art [F.W. 32] including Fischer

No. 2,540,251 (Item N in Book of Patents). He also advised that "Applicant should point out distinguishing structural features recited in his claims [F.W. 33].

Fischer No. 2,540,251 illustrates and describes exactly what appellant's counsel says in the italicized quotation from his Brief is patented by Worson.

Thus, Fischer states:

"This invention relates to contraction joints embedded in concrete pavements as a means whereby cleavage of a section of pavement under internal stresses of contraction may be restricted to desirable geometrical lines." Col. 1, lines 1-5.

Further:

"One object of the invention is to provide suitable constructions of thin subdivision plates which, by extending through a suitable proportion of the vertical dimension of the paving slab * * * will enable the slab under stresses of contraction developing therein, to pull apart in said planes rather than elsewhere." Col. 1, lines 13-20.

Then:

"Another object of the invention is to provide waterstop means in association with any of the various types of contraction joint plates herein contemplated; * * *." Col. 2, line 7. Fischer mentions various materials, including "rubberized bituminous material." Col. 2, lines 25-26.

After the citation of Fischer, Worson's attorney interviewed the Examiner, and filed an amendment cancelling claims 1-12, substituting claims 13-15, and argued for allowability of such combination claims. These claims were in form defining a combination of ele-

ments making up a paving section with elements as set forth by appellant's counsel in the italicized quotation above.

They were rejected as "unpatentable" over the art [F.W. 41].

Worson's attorney asked for reconsideration, and argued patentability [F.W. 42].

Without waiting for an office action, the attorney again interviewed the Examiner and thereupon filed a supplemental amendment presenting the claims which appear in the patent [F.W. 47].

In his remarks, previously quoted, the attorney referred to the desirability of revising the "form" of the claims. But the expressed purpose of the new claims was, in his own language, "to patentably distinguish over the prior art." If they did not, and the "invention" is the redefined combination asserted by appellant as quoted above, and can be expanded by reference to equivalents, appellant is sealing the doom of its patent for invalidity.

Appellant's attempt by affidavits and argument to broaden the Worson claims by so redefining the combination and applying to the redefinition the doctrine of equivalents not only is contra to the *D & H Electric* case, *supra*, but is squarely rejected by the United States Supreme Court in the companion cases of *Graham v. John Deere*, *Calmar v. Cook Chemical Company*, and *Colgate-Palmolive Company v. Cook Chemical Company*, 383 U.S. 1, 15 L.ed. 2d 545, 86 S.Ct. 684, 148 U.S.P.Q. 459, opinion by Mr. Justice Clark. We quote some of the Court's language, 383 U.S. at 32, 15 L.ed. 2d at 564, which applies directly to counsel's departure from the position he took before the Patent Office.

“Let us first return to the fundamental disagreement between the parties. Cook Chemical, as we noted at the outset, urges that the invention must be viewed as the overall combination, or—putting it in the language of the statute—that we must consider the subject matter sought to be patented taken as a whole. With this position, taken in the abstract, there is, of course, no quibble. But the history of the prosecution of the Scoggin application in the Patent Office reveals a substantial divergence in respondent’s present position.

“As originally submitted, the Scoggin application contained 15 claims which in very broad terms claimed the entire combination of spray pump and overcap. No mention of, or claim for, the sealing features was made. All 15 claims were rejected by the Examiner because (1) the applicant was vague and indefinite as to what the invention was, and (2) the claims were met by Lohse. Scoggin canceled these claims and submitted new ones. Upon a further series of rejections and new submissions, the Patent Office Examiner, after an office interview, at last relented. It is crystal clear that after the first rejection, Scoggin relied entirely upon the sealing arrangement as the exclusive patentable difference in his combination. It is likewise clear that it was on that feature that the Examiner allowed the claims. In fact, in a letter accompanying the final submission of claims, Scoggin, through his attorney, stated that ‘agreement was reached between the Honorable Examiner and applicant’s attorney relative to *limitations* which must be in the claims in order to define novelty over the previously applied disclosure of Lohse when consid-

ered in view of the newly cited patents of Mellon and Darley, Jr.' (Italics added.)

“Moreover, those limitations were specifically spelled out as (1) the use of a rib seal and (2) an overcap whose lower edge did not contact the container cap. * * * In other words, the Scoggin invention was limited to the use of a rib—rather than a washer or gasket—and the existence of a slight space between the overcap and the container cap.”

Returning to the Utecht affidavit, it is merely an argument that the *tapers* recited in the claims in order to secure their allowance were for the purpose of describing the upper and lower edges of the fracturing band as “straight edges.” That such an assertion is specious is demonstrated by the fact that there are numerous fracturing bands with straight edges in the prior art. See file wrapper references Heltzel No. 2,330,214, and Kelley No. 2,759,403 (Items O and P in Book of Patents). A common door has upper and lower straight edges without being tapered. We again emphasize that the recited taper in the claims was the necessary limitation to obtain the patent.

A case uniquely in point on the subject of a taper limitation and non-infringement is *Fowler v. Detroit Bedding Co., et al.*, 47 F.2d 756 (C.A. 6, 1931). The claim in suit read as follows:

“A padding bandage consisting of a long, narrow strip formed of a central core of relatively stiff and strong paper in combination with and inclosed by an outer surface made up of an unabsorbent fibrous bat having tapered edges folded about the core and with its tapered edges lapped on one side of the paper core.”

In affirming the District Court's judgment of non-infringement, the Court of Appeals said:

"The defenses were invalidity and noninfringement. If the patent is valid (which we need not decide), the invention consists in so tapering and overlapping the ends of the bat that when it is folded about the core a bandage of uniform thickness results, or in the simplicity with which the bandage is manufactured, by merely tapering the ends of the bat before folding it. For such a product the appellant has limited the claim to 'tapered edges lapped on one side of the paper core' and he is bound thereby. *Lakewood Engineering Co. v. Stein*, 8 F. (2d) 713, 715 (C.A.C. 6); *Michigan Engine Valve Co. v. Monarch Mfg. Co.*, 233 F. 107, 110 (C.C.A. 6); *McCallum v. Pittsburgh & Cleveland Coal Co.*, 268 F. 831, 835 (C.C.A. 6). All the substantial evidence indicates that appellee's product lacked this element of appellant's combination and therefore did not infringe. *Cimiotti Unhairing Co. v. American Fur Ref. Co.*, 198 U.S. 399, 410, 25 S.Ct. 697, 49 L.Ed. 1100."

Referring to the defendants' structure, the Court said:

"* * * Any slight tapering of the edges was not due to design, but was incidental to the manner in which the sheet or bat of the material came from the machine or to the effect of forcing it into the pleat of the cushion."

In the present case the District Court, in its memorandum opinion of June 30, 1967 [R 371, A 2], specifically determined in respect to the tapering form of the Worson band 12, "that this limitation is an essen-

tial element of the claim, in fact the very element which the examiner thought made the claim patentable. Since the alleged infringing device does not come within this limitation, its obvious non-infringement leaves no substantial question of fact to be determined at the time of trial.”

Absence of Serration Means.

The second element of the Worson patent claims which is clearly omitted from appellees’ structure is the serration means on the waterstop strips.

The claims in suit call for horizontally extending sealing strips “each being formed with longitudinally extending serration means that are firmly embedded within said paving as said paving cures.” The specification states that the sealing strips “are serrated to define longitudinal ribs 19 and are formed at their free ends with an enlarged anchor element 20.” (Patent Col. 2, lines 55-57).

The serrations and the anchor elements are independent *and* separate. Their respective functions are described in the patent, Col. 2, paragraph beginning line 68 as follows:

“Referring now to FIGURE 4, at such times as the slabs 26 and 28 undergo relative movement away from one another, the aforescribed device D will serve as an effective waterstop. In this regard, the water 30 entering the slot 22 above the band 12 will not be able to flow downwardly past the sealing strips 14 and 16 inasmuch as the ribs 19 thereof will cooperate with the ridges 31 formed in the paving material wherein they are embedded to prevent any percolation of such water outward-

ly along the sealing strips. * * * It should also be observed that the provision of the enlarged anchor elements 20 of the sealing strips 14 and 16 reduce the possibility that these strips will become loosened from the paving material P during relative movement between the slabs 26 and 28.”

While the serrations are included as claim elements, the enlarged anchor elements are not mentioned in the claims.

The longitudinally extending serrations were included in original application claims 3, 4, 7, 8 and 12 but no enlarged anchor means [F.W. 14-23].

Original claims 6 and 10 included enlarged anchor means but no serrations [F.W. 17 and 21].

Original claim 11 contained both “longitudinally extending serrations” and “enlarged anchor means.” Thus they are treated as separate and independent elements.

These claims were all rejected. In due time they were cancelled, and claims 13-15 substituted [F.W. 35-37]. The new claims included “longitudinal serration means” but no enlarged anchor means. The claims were rejected.

In the attorney’s response to the Patent Office, F. W. 42 *et seq.*, he argued at page 43:

“Assuming, however, that the Kelley device were formed of the resilient material of the British patent, the resulting device would not meet the limitations of the applicant’s claimed combination nor would it be workable. The applicant’s horizontally extending sealing strips are recited as being formed with longitudinally extending serration means. *It is absolutely essential* that such serration means be

provided in order to lock the applicant's trips to the adjoining paving slabs 60 and 62. Unless these sealing strips are so locked to the adjoining paving slabs, they cannot function as a waterstop, particularly, when the adjoining paving slabs undergo horizontal separation, as indicated in Fig. 4 of the applicant's drawings." (Emphasis added).

These "absolutely essential" longitudinally extending serration means that are firmly embedded within the paving as the paving cures were carried over into claims 16-18 which became claims 1-3 of the patent.

Worson's attorney further emphasized the importance of these serration means in his argument, F.W. 51 in the following language:

"The new claims [16-18] also recite the applicant's integral horizontally extending sealing strips 14 and 16 as being formed with longitudinally extending serration means that are firmly embedded within the paving as the latter cures. This arrangement insures that the sealing strips will restrain the downward flow of water through the joint while relative movement is permitted by the paving sections on either side of the weakened plane joint."

Nothing was said concerning the enlarged anchor means. They are the marginal enlargements 20. We repeat, they are not included as elements of the combination claimed in the patent claims.

As pointed out above, the Worson affidavit, page 12 [R 257], makes reference to the defendants' structure as having horizontally extending sealing strips "formed with longitudinally extending projections." These can only be the marginal beads, and correspond in position

and function to the Worson patent enlarged anchor elements or means 20. Worson's affidavit changes terminology and (same page) calls defendants' marginal beads 'generally cylindrical protrusions.' Either terminology is acceptable, and taken in conjunction with a lack of reference to the Worson enlarged anchor elements 20 constitutes an admission that the defendants have no serrations. There being no substitute whatever, there can be no equivalent.

Appellant would have this Court believe that because the file history contains no language "indicating that the patentee narrowed his description" of the serration means "because of the prior art," (Op. Br. 24) there is no estoppel to broadly construe the element.

In this argument, appellant overlooks the proposition that the file history may be referred to in order to ascertain what the applicant urged as new and as constituting a material element of the patent claims.

Appellant's Day in Court on Findings 27-33.

Appellant argues that it did not have its day in court on the subject of serration means (Op. Br. pp. 20-21). This is developed by an attack upon findings of fact 27-33 and the procedural steps culminating in their adoption and filing.

Such criticism is based upon a misconception. Rule 52(a) F.R.C.P. provides "Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 * * *."

Local Rule 3(g) 1. Rules of the U.S. District Court for the Central District of California* does re-

*Erroneously referred to in Appellant's Opening Brief, pp. 17, 19, 20, 30 and 42 as Local Rule "4".

quire that "There shall be served and lodged with each motion for summary judgment pursuant to Rule 56 of the F.R.C.P. proposed findings of fact and conclusions of law and proposed summary judgment. Such proposed findings shall state the material facts as to which the moving party contends there is no genuine issue."

There is no requirement in the rules that the findings ultimately be made or filed.

The provision seems to be mainly for the purpose of focusing the points in controversy because Local Rule 3(g) 2 states that "Any party who opposes the motion shall, * * * serve and file a concise 'statement of genuine issues' setting forth all material facts as to which it is contended there exists a genuine issue necessary to be litigated."

These presentations are preliminary only and the Court is not bound by either of them.

The serration means of the Worson patent is referred to in the motion for summary judgment [at R 173], and absence of serration means in appellees' structure was pointed out in the motion [at R 188]. Proposed finding 12 [at R 221] also recites this fact. Vigorous response was offered in the Worson affidavit [at R 257]. Arguments were presented in open court [Transcript of Proceedings June 5, 1967 at pages 19-24]. After the District Court's decision, new findings were lodged [R 351] dealing in fuller detail with the serration means subject [at R 362-365]. After a hearing [Transcript of Proceedings June 26, 1967] the findings lodged [R 351] were signed and filed June 30, 1967.

Appellant's contention is vacuous. Even if the controversy over serration means lacked the historical sequence outlined, it would not be grounds for reversal.

III.

The Prior Art Cited by the Patent Office Can Be Readily Understood by the Court Without the Aid of Expert Testimony, and Imposes Such Restriction in Construing the Claims That Appellees' Structures Must Fall Outside the Scope Thereof.

The examiner cited seven patents as references during the prosecution of the Worson application. These are identified and briefly described in Findings of Fact 17, 19, and 21 [R 357, and A 10-12]. They disclosed elastomeric joints and joints of other materials for concrete pavements, of cruciform and other cross sectional forms, serving as weakened plane joints and waterstops, the weakened plane joints providing for fracturing of the concrete along desired lines, and the waterstops preventing water from seeping through the concrete. Copies of the patents are in the Book of Patents before the court. The findings amply demonstrate that the District Court had no difficulty in understanding the disclosures.

In addition to the file wrapper references, the motion for summary judgment presents numerous additional examples of prior art [R 176]. Copies are in the Book of Patents, and reproductions of pertinent views of the respective drawings are contained in the motion. The District Court apparently felt so convinced of its position on non-infringement that it made no mention in its memorandum opinions nor in the find-

ings of these additional patents. They show even more forms of cleavage inserts and waterstops than are revealed in the references of record. They are readily understood without the aid of expert testimony, and if examined reinforce the narrow construction imposed of necessity upon the Worson patent claims.

IV.

A Case for Summary Judgment Was Fully Established, and It Was Proper for the District Court to Dispose of It Accordingly.

The facts compelling the conclusion of noninfringement are clearly established by plaintiff's admissions, undisputed documents of record, exhibits included within the documents, and the exhibits before the Court. In such case, ". . . the question of infringement resolves itself in each case into one of law, depending upon a comparison between the structure disclosed on the face of the patent and the [accused] device . . ." *Sanitary Refrigerator Co. v. Winters*, (1929) 280 U.S. 30, 36, 74 L.Ed. 147, 153.

Accord *Kwikset Locks v. Hillgren*, (9 Cir., 1954), 210 F.2d 483, 488, 489; cert. den. 347 U.S. 989, 98 L.Ed. 1123; *Oxnard Cannery v. Bradley*, (9 Cir., 1952), 194 F. 2d 655, 659, cert. den. 343 U.S. 978, 96 L.Ed. 1370; *Rohr Aircraft Corp. v. Rubber Teck*, (9 Cir., 1959), 266 F.2d 613; 121 U.S.P.Q. 241.

Since the undisputable facts clearly establish that none of the identities required by law to find infringement are present, the legal conclusion on noninfringement is inescapable.

The District Court expressly held that there is no genuine issue of material fact on the question of non-

infringement. Memorandum Opinion filed June 30, 1967 [R. 371, at 372], Finding 9 [R. 354].

Appellant's attempts to create issues (Op. Br. 30) are insubstantial. The file history is unambiguous. Neither it, nor the patent claims can be "explained" or "qualified" by affidavits.

Disposition of the case on a finding of noninfringement without passing on validity is sanctioned. *M.O.S. Corp. v. John I. Haas Co., Inc.*, 9 Cir., 1967, 375 F.2d 614, 153 U.S.P.Q. 153. *Supra*, footnote p. 6.

Because of the doctrine announced in *Sinclair & Carol Co. v. Interchemical Corp.*, 1954, 325 U.S. 327, 65 U.S.P.Q. 297, that of the questions of noninfringement and validity, validity has the greater public importance, and that usually the better practice is to inquire fully into the validity of a patent, this Court considered and now recognizes that such is not a rule but is only an admonition. *M.O.S. Corp., supra*.

Bearing in mind that the admonition is not to be lightly disregarded, we will briefly discuss the situation presented by the present case.

The patented structure is not one which the public clamors to buy, or has to have. It is not a necessity of life, or even a convenience to the consuming public. By its nature it is utilized, if at all, by contractors in construction projects. However, it is not a necessity for them. There are various ways of achieving the same purpose and result, as disclosed in the Worson patent itself, and in the prior art before the Court. Appellees obtain the structural requirements by means held not to infringe, and also by the use of an alternative form of insert which appellant does not even charge to be an infringement. See the voluntary admission of

appellee Peter Kiewit Sons' Co. in Preface to Interrogatory No. 33 [R. 128], physical Interrogatory Exhibit G, and Interrogatory Exhibit H, a drawing [R 140]. Appellant's answer to Interrogatory No. 33 is a disclaimer of any charge of infringement by the alternative form [R 144].

Under these circumstances, the public interest in the validity or invalidity of the patent is not clearly discernible, and efficient administration of justice justifies complete disposition of the controversy between the parties by the holding of noninfringement.

Appellant's Citations Are Inapposite to the Present Case.

The various decisions cited by appellant where summary judgment was held by a court of appeals to be improper all respond to the interpretation of Rule 56(c) F.R.C.P. stated in *Cee-Bee Chemical Co., Inc. v. Delco Chemicals, Inc.*, 9 Cir., 263 F.2d 150, 152, 120 U.S.P.Q. 72, 73.

"If the conclusions reached by the trial court required it to first resolve a genuine issue as to a material fact, the case should not have been disposed of on a motion for a summary judgment." (Quoted on p. 29 of Op. Br.).

This and other cases rejecting disposition by summary judgment involve various facts in controversy presented by conflicting affidavits, uncertainties, material issues on which evidence should have been presented, or failure to include essential documents in the record.

Appellant lays great stress on *Yardley Created Products v. Clopay Corp.*, 7 Cir., 324 F.2d 932, 139 U.S.P.Q. 218 (Op. Br. 29). The Court there noted

that the issue of file wrapper estoppel presented factual questions. The real problem in the *Yardley* case was that a necessary file wrapper history and the prior art were not included in the record.

Decisions Which Sustain Summary Judgment on Non-Infringement.

In full support of appellees' position, see *Morpul, Inc. v. Glen Raven Knitting Mill, Inc.*, 4 Cir., 357 F.2d 732, 149 U.S.P.Q. 1. There the court affirmed a summary judgment of non-infringement of a patent for a combination garment of ladies' seamless stockings and panty. The meaning of a U-shaped "seam" was involved. The patentee sought a broad interpretation and offered to show that workmen skilled in the art considered the term broad enough to cover the defendant's crotch piece. The court pointed out that the file history was so incontrovertibly clear that no genuine issue of fact existed, that the claim must be interpreted narrowly, and so was not infringed.

The same conclusion applies to the present case.

See also other cases affirming summary judgment for noninfringement of mechanical patents:

Smith v. General Foundry Mach. Co. Inc., 4 Cir., 174 F.2d 147, 81 U.S.P.Q. 297, cert. den. 338 U.S. 869, 83 U.S.P.Q. 543 (tobacco drying house).

Steigleder v. Eberhard Faber Pencil Co., 1 Cir., 176 F.2d 604, 82 U.S.P.Q. 323, cert. den. 338 U.S. 893, 83 U.S.P.Q. 544 (liquid ink eraser for fountain pens using principle of ball valve).

Parke, Davis & Company v. American Cyanamid Company, 6 Cir., 207 F.2d 571, 99 U.S.P.Q. 237 (patent for antianemia vitamin products).

Sunbeam Lighting Company v. Pacific Associated Lighting Incorporated, 9 Cir., 328 F.2d 300, 140 U.S.P.Q. 512 (design patent for combined hospital and bed light fixture and service outlet control panel).

Fromberg, Inc. v. Gross Manufacturing Company, *supra*, 9 Cir., 328 F.2d 803, 140 U.S.P.Q. 641 (device to repair tubeless automobile tire).

Attention is also called to a well reasoned and documented district court opinion by the late Judge William C. Mathes, in *Dolgoft v. The Kaynar Company*, S.D. Cal., Central Div., 18 F.R.D. 424, 108 U.S.P.Q. 66 (no F.Supp. citation found, and no appeal noted). The patent held not infringed was for a device to hold hair in place so as to form a pin curl while the hair is being set.

V.

If the Court of Appeals Elects to Affirm on the Ground of Invalidity, the Record Amply Sustains Such a Determination.*

The subject of invalidity of the Worson patent was treated at length in the motion for summary judgment, commencing at page 7 [R 176].

The German Gebrauchsmuster 1,756,880 [R 176, and Item B in Book of Patents] is conceded by appellant to be prior art, but its applicability is challenged in the Worson affidavit on the grounds that the cruciform plastic insert is employed in a different type of concrete construction than that contemplated by Worson.

*We assume that appellant's conclusion (Op. Br. 37) that "The District Court erred in * * * holding the patent in suit invalid" was unintended. The holding was non-infringement.

The German insert embodies a vertical band, horizontal wings, and serration means. The only thing it lacks is a taper in the vertical bands.

To utilize the German insert in wet concrete would be obvious in the light of various prior art disclosures of inserts used to form weakened plane joints. See Fischer, U.S. No. 1,997,545, Heltzel, U.S. No. 1,946,972 Figure 8, McInerney, U.S. Reissue 17,361, or Heltzel, U.S. No. 2,025,449 Figures 8A and 8B. Tapering the vertical band cannot be unobvious. Appellant itself says that it was old in the art. (Op. Br. 23).

Appellees' case for affirmance on the ground on invalidity could be predicated entirely on *Walker v. General Motors Corp., et al.*, 9 Cir., 1966, 362 F.2d 56, 149 U.S.P.Q. 472, or *Alladin Plastics, Inc. v. Jerrold Stephan Co.*, 9 Cir. 1966, 362 F.2d 532, 150 U.S.P.Q. 10.

The patent involved in the *Walker* case contained three claims defining combinations wherein the asserted novelty was a fuel tank built into a fender. The prior art was represented primarily by an article in a French magazine.

On a motion for summary judgment, the district court held the patent claims to be invalid for anticipation, 225 F. Supp. 350, 139 U.S.P.Q. 434.

The Court of Appeals for the Ninth Circuit affirmed the judgment, and in doing so, ruled that two of the three claims were not actually anticipated but were invalid under 35 U.S.C. §103 for obviousness.*

*That section reads:

§ 103. *Conditions for patentability; non-obvious subject matter*

(This footnote is continued on the next page)

In doing so, this Court rejected contentions of the plaintiff that factual disputes did exist which were relevant to the issue of obviousness, particularly as to the prior art, the level of ordinary skill in the art, also unsatisfied need, commercial success, and acceptance of a license by another corporation.

A month after the *Walker v. General Motors* decision this Court affirmed another district court decision holding patents invalid for obviousness on a motion for summary judgment. *Alladin Plastics, Inc. v. Jerrold Stephan Co., supra.*

Two of the patents involved “bucket seat” chair construction, and the third was for a design.

The following paragraphs from Circuit Judge Browning’s opinion clearly define the policy in the Ninth Circuit:

“[1] A patent may be declared invalid by summary judgment on the ground of obviousness (35 U.S.C. § 103) if it appears from undisputed facts that the subject matter of the patent would have been obvious to a person skilled in the art who was aware of such matters as were in the public domain. *Walker v. General Motors Corp.*, 362 F.2d 56 (9th Cir. 1966).

* * *

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patenability shall not be negatived by the manner in which the invention was made.

“[3] All three patents are readily understood. The claimed advances over prior art are clearly described in appellant’s answers to interrogatories. Detailed exposition of the prior art and of the level of skill of persons engaged in it were unnecessary, for it is clear from the undisputed facts that the patents disclose advances which would have been obvious. The advances being obvious, appellant’s proffered evidence of the pre-patent problems and the success of appellant’s patented solutions could not have affected the result. *Walker v. General Motors Corp.*, 362 F.2d 56 (9th Cir. 1966).”

The Court of Appeals can decide the issue of invalidity if it so desires even though the District Court did not. *M.O.S. Corporation v. John I. Haas Co., Inc.*, *supra*, 9 Cir., 375 F.2d 614, 153 U.S.P.Q. 153; *Illinois Tool Works, Inc. v. Brunsing et al.*, *supra*, 9 Cir., 378 F.2d 235, 153 U.S.P.Q. 771.

It is recognized that this Court has ruled summary judgment of invalidity to be improper where questions of fact, including whether an improvement was obvious, are such as to require presentation of evidence. *Hughes Blades, Inc. v. Diamond Tool Associates*, 9 Cir., 300 F.2d 853, 132 U.S.P.Q. 305; *Cee-Bee Chemical Co., Inc. v. Delco Chemicals, Inc.*, *supra*, 9 Cir., 263 F.2d 150, 120 U.S.P.Q. 72.

Such cases can be distinguished from the one at bar, which parallels other decisions of this Court, where the subject matter is apparent and readily understood.

See also *Wham-O-Mfg. Co. v. Paradise Manufacturing Co.*, 9 Cir., 1964, 327 F.2d 748, 140 U.S.P.Q. 357, holding invalid for obviousness on a motion for sum-

mary judgment a patent on an amusement slide combined with a sprinkler to make it more slippery. Circuit Judge Koelsch said, in part, at page 751:

“* * * We think, as did the trial court, that the combination was obvious. Particularly apt are the following extracts from *Glagovsky v. Bowcraft Trimming Co.*, 267 F.2d 479 (1st Cir. 1959), cert. den. 361 U.S. 884, 80 S.Ct. 155, 4 L.Ed. 2d 120 (1959), a case very much like the one before us: ‘The prior art and the patent claims are so simple that they can be readily understood by any normally intelligent person without the aid of expert testimony. There was, therefore, no error below in disposing of the plaintiff’s suit on the motions for summary judgment and their supporting affidavits, depositions and exhibits.’ (267 F. 2d p. 480). ‘* * * The plaintiff’s advance may well be useful and ingenious. But making full allowance for the presumption that the patent is valid and placing the burden of establishing its invalidity on the defendant, 35 U.S.C. § 282, it does not seem to us that even in the light of plaintiff’s commercial success it can be said that the plaintiff’s contribution, viewed either against the background of the allied prior arts * * * or against the background of the particular prior art * * * can be called an invention without defining that term to describe no more than the sort of advance to be expected from any ordinarily skillful mechanic conversant with any of the arts involved.’ (267 F.2d p. 482).”

Other cases decided by this and other courts of appeal, adjudging patents invalid in summary judgment proceedings are:

Montmarquet v. Johson & Johnson, 3 Cir., 82 F. Supp. 469, 80 U.S.P.Q. 404, aff'd 179 F.2d 240, 85 U.S.P.Q. 147, cert. den. 339 U.S. 979, 85 U.S.P.Q. 527, patent on athletic supporter.

Park-In-Theatres v. Perkins, 9 Cir., 190 F.2d 137, 90 U.S.P.Q. 163, holding invalid for want of invention, a patent on an outdoor theater.

Bobertz v. General Motors Corp., 6 Cir., 228 F.2d 94, 107 U.S.P.Q. 338, holding invalid a patent for an automobile hood.

Vermont Structural Slate Company, Inc. v. Tatko Brothers Slate Company, Inc., 2 Cir., 233 F.2d 9, 109 U.S.P.Q. 306, cert. den. 352 U.S. 917, 111 U.S.P.Q. 468, holding invalid a patent for a pallet for holding, transportation and/or storage of slate slabs.

Rankin et al. v. King et al., 9 Cir., 272 F.2d 254, 123 U.S.P.Q. 397, holding invalid a patent for a drapery and rod combination.

Ronel Corporation v. Anchor Lock of Florida, Inc., 5 Cir., 325 F.2d 889, 140 U.S.P.Q. 7, cert. den., 337 U.S. 924, 141 U.S.P.Q. 950, holding invalid a patent for a metal fastener, on comparison with prior art, notwithstanding opposing affidavits.

Methode Electronics, Inc. v. Elco Corporation, 3 Cir., 385 F.2d 138, 155 U.S.P.Q. 353, holding invalid a patent for an electrical connector.

In considering the question of invalidity here, it is pertinent to recall the "severe test" rule approved by this Court. The Worson patent is for a combination of

old elements. To be sustained, it must meet the “severe test” whether the whole in some way exceeds the sum of its parts to produce unusual or surprising consequences from the unification of the elements. *Santa Anita Mfg. Corp. v. Lugash*, 9 Cir., 369 F.2d 964, 152 U.S.P.Q. 44.

Weakened plane joints in concrete construction, and waterstops are shown to be very common. Moreover, they are illustrated not only singly, but combined in a single unit. Worson does not provide anything which produces unusual or surprising consequences. His vertical bands weaken the concrete to insure predetermined lines of cracking, and his horizontal strips seal off water, all in the same fashion as was known long before him.

Commercial success, long felt want, level of ordinary skill in the art, even if proved cannot tip the scales of patentability in a case such as this, where his whole conception was obvious to any normally intelligent person upon a perusal of the clear disclosures in the prior art.

Conclusion.

The narrow definitions in the claim language, the file wrapper history and limitations imposed thereby, and the prior art, all of which are readily understood without resort to testimony, expert or otherwise, either singly or *in toto*, fully support the District Court’s determination that there was no genuine issue of material fact on the question of non-infringement, and the Court properly disposed of the case on such ground.

No discernible substantial public interest in the validity or invalidity of the patent sufficient to require adjudication appears from the record, but if the Court of Appeals elects to consider that question, claims 1 and 2 of the patent, which are the only ones in issue, are invalid for obviousness.

Los Angeles, California, March 12, 1968.

Respectfully submitted,

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Certificate.

I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

HERBERT A. HUEBNER





APPENDIX CONTAINING PORTIONS
OF RECORD ON APPEAL

Memorandum Opinion.

[R 329]

United States District Court, Central District of California.

Edoco Technical Products, Inc., Plaintiff, vs. Peter Kiewit Sons' Co., Defendant, and The B. F. Goodrich Company, Intervening Defendant. No. 66-1497-JWC.

Filed: June 7, 1967.

I am of the opinion that the defendant's motion for summary judgment should be granted upon a consideration of the issue of non-infringement only. As to the question of validity and misuse of the patent, no determination can be made upon a motion for summary judgment as material questions of fact still remain to be resolved.

The motion for summary judgment, therefore, is granted and defense counsel shall prepare new findings of fact, conclusions of law and judgment in accordance therewith.

Dated this 7 day of June, 1967.

Jesse W. Curtis
United States District Judge

Memorandum Opinion.

[R 371]

United States District Court, Central District of California.

Edoco Technical Products, Inc., Plaintiff, vs. Peter Kiewit Sons' Co., Defendant, and The B. F. Goodrich Company, Intervening Defendant. No. 66-1497-JWC.

Filed: June 30, 1967.

After the argument upon the objections to the proposed findings, it became apparent that some memorandum of the court might be appropriate in order that the parties might fully understand the basis of my ruling upon the motion for summary judgment.

The Worson patent relates to a combination of elements well known in the arts. The file wrapper discloses that before the patent was finally allowed, a series of attempts were made to obtain the approval of claims of much broader scope than those finally allowed, some of which would undoubtedly have embraced the alleged infringing device. But these earlier claims were all rejected. It was only when the following limitation was added that the patent was allowed.

"The upper portion of band 12 tapers upwardly for a distance greater than the thickness of the band to provide a continuous upper straight edge while the lower portion of the band tapers downwardly at a distance greater than the thickness of the band to provide a continuous straight edge at the lower end of the band."

It would appear, therefore, that this limitation is an essential element of the claim, in fact the very element which the examiner thought made the claim patentable. Since the alleged infringing device does not come within this limitation, its obvious non-infringement leaves no substantial question of fact to be determined at the time of the trial.

Furthermore, as I construe claims 1 and 2 in the light of the file wrapper, the alleged infringing device does not come within the doctrine of equivalents. There are on file affidavits expressing contrary conclusions, but these do not in my opinion raise any real questions of fact.

The motion for summary judgment should, therefore, be granted, and the objections to the findings of fact and conclusions of law are hereby overruled.

Dated this 30 day of June, 1967.

Jesse W. Curtis
United States District Judge

Findings of Fact and Conclusions of Law.

[R 351]

In the United States District Court, Central District of California.

Edoco Technical Products, Inc., Plaintiff, vs. Peter Kiewit Sons' Co., Defendant, and The B. F. Goodrich Company, Intervening Defendant. Civil Action No. 66-1497 JWC.

FINDINGS OF FACT

1.

(a) This is an action for alleged infringement of United States Letters Patent No. 3,023,681, granted March 6, 1962, on an application of Lee Worson, for "Combined Weakened Plane Joint Former and Water-stop" (hereinafter referred to as "the Worson patent" or "the patent in suit") filed by plaintiff, Edoco Technical Products, Inc., initially against defendant, Peter Kiewit Sons' Co. The B. F. Goodrich Company made application to this Court for leave to intervene as a party defendant, which was granted by the Court, and unless referred to individually, the defendant, Peter Kiewit Sons' Co. and the defendant, The B. F. Goodrich Company are hereinafter referred to as "defendants."

(b) Defendants answered the complaint averring invalidity of the patent in suit, denying infringement, and charging plaintiff with unlawful misuse of the patent whereby plaintiff is estopped from maintaining the action. Defendants also filed counterclaims affirmatively seeking declaratory judgments in accordance with their answers to the complaint. Plaintiff replied to the counterclaims, admitting a controversy with

defendant Peter Kiewit Sons' Co., but denying a controversy with defendant The B. F. Goodrich Company, and admitting that B. F. Goodrich had not infringed. The latter admission, construed in the light of plaintiff's answers to defendants' interrogatories inconsistent with the admission, afford insufficient protection to defendant B. F. Goodrich because it leaves that defendant's customers open to suit for infringement, and does not remove the controversy.

(c) An actual controversy exists within the jurisdiction of this Court relative to the validity of Patent No. 3,023,681, the infringement thereof by the defendants, and the rights of the defendants thereunder.

2.

After the pleadings were closed and the plaintiff had filed answers to interrogatories propounded by defendant Kiewit, and answers to additional interrogatories filed by both defendants, the defendants brought the case on for final determination by a Motion for a Summary Judgment, praying for dismissal of the action, with prejudice, on the ground that the Court could determine as a matter of law that the patent in suit as to the claims sued on is invalid, and that defendants are not infringing the patent in suit, either directly or indirectly, and that defendant Goodrich has not contributorily infringed, or actively induced infringement, and that plaintiff has unlawfully misused the patent in suit and is therefore estopped to maintain this action.

3.

Jurisdiction of this Court was properly invoked upon the ground that the plaintiff's cause of action arises

under the patent laws of the United States, and the Court has jurisdiction of the subject matter of the action under the provisions of Judicial Code 28 U.S.C. § 1338, § 1400, including jurisdiction of defendants' counterclaims under 28 U.S.C. § 2201 and § 2202.

4.

Plaintiff, Edoco Technical Products, Inc., is a corporation organized and existing under the laws of the State of California, and has a place of business at 22039 South Westward Avenue, Long Beach, California 90810.

5.

(a) Defendant, Peter Kiewit Sons' Co., is a corporation organized and existing under the laws of the State of Nebraska; has a regular and established place of business at 301 East Santa Clara Street, Arcadia, California; and has appointed as its agent for service of process in the State of California, CT Corporation Systems, 510 South Spring Street, Los Angeles, California.

(b) Defendant, The B. F. Goodrich Company, is a corporation organized and existing under the laws of the State of New York, and has a regular and established place of business in the City of Los Angeles, County of Los Angeles, State of California.

6.

Acts of the defendants charged to infringe the patent in suit have been committed by the defendants within the former Southern District of California, and defendants have waived any question of venue which might arise from the realignment of judicial districts.

7.

This Court has jurisdiction of the parties.

8.

Plaintiff is the owner of the patent in suit. By answers to interrogatories it has expressly identified the subject matter of the alleged infringement, and by such answers has limited its charge of infringement to claims 1 and 2 of the patent in suit. The remaining claim, numbered 3, is not in issue and is not considered by this Court.

9.

There is no genuine issue of material fact before this Court on the question of non-infringement arising out of the motion for summary judgment, final disposition of the case can be predicated upon said motion, and all issues not decided upon said motion are moot and are disregarded.

10.

The patent in suit is directed to a paving section which may be concrete, wherein is embedded a fracturing band vertically disposed, and a waterstop horizontally disposed, the two parts being integrally connected together. The upper portion of the band tapers upwardly for a distance greater than the thickness in the central region of the band, and the lower portion of the band tapers downwardly for a distance greater than the thickness of the central region of the band. Opposite edges of the band are straight. Preferably, although not necessarily, the band and waterstop are formed of a resilient material, such as a synthetic plastic. The waterstop comprising the horizontal strips is serrated to define longitudinal ribs and is provided at its outer edges with enlarged anchor elements. The purpose of

the vertical strips is to separate the poured concrete along a predetermined relatively straight line for a portion, but not all, of the depth of the concrete, whereby when the concrete cures and contraction occurs, the concrete will tend to crack and separate in or near the vertical plane of the edges of the band. Subsequently, when expansion and contraction occurs, due to changes in temperature, the same lines provide for such, and indiscriminate cracking is minimized, if not prohibited. The waterstop which remains embedded in the concrete is to prevent water which seeps through the uppermost crack from making its way to the ground underneath the concrete.

The foregoing description relates to the form of structure illustrated in Figures 1-4 of the patent in suit and is allegedly protected by claims 1 and 2. A sample of plaintiff's fracturing band and waterstop (gray in color), responding to claims 1 and 2, is before the Court as Hearing Exhibit 1.

Inasmuch as plaintiff makes no contention that claim 3 is infringed, and such claim reads only on the form illustrated in Figures 5-8, such figures may be disregarded.

11.

Defendant, Peter Kiewit Sons' Co., has performed concrete lining operations in a section of what is known as the San Luis Canal in the general vicinity of Cantua Creek, in the County of Fresno, State of California, and is continuing in the performance of a contract for such work. Included in the construction of said concrete lining are weakened plane joints, sometimes called contraction joints, comprising polyvinyl chloride strips cruciform in cross section which are inserted in the con-

crete as it is laid, or soon thereafter, while the concrete is still soft; certain of such strips extend longitudinally of the canal, and other strips extend transversely thereof. The lines represented by these strips generally define approximately 15 ft. squares, although this dimension varies. Samples of the strips are before this Court as Interrogatory Exhibits. Exhibit A is a sample of blue material, and Exhibit B is a sample of white material. The blue material is laid longitudinally, and the white material is laid transversely. Interrogatory Exhibit C is a drawing in which Figure 1 illustrates the blue material in place in the concrete as laid and before curing. Figure 2 illustrates the same cross section of concrete as Figure 1 after the concrete has cured and contraction lines have appeared. Figure 3 is a fragmentary plan view of a portion of the concrete lining illustrating 15 ft. squares defined by the contraction lines. Insofar as this case is concerned, there is no distinction between the white and the blue material.

12.

The vertical elements of the strips described in Finding 11 are not tapered in either direction but embody flat, parallel outside surfaces. The horizontal water-stop element embodies no serrations, but merely enlarged beads along the outer edges.

13.

Defendant The B. F. Goodrich Company furnished the strip material described in Findings 11-12 to defendant Peter Kiewit Sons' Co. which the latter used in the canal construction, and B. F. Goodrich continues to furnish such material to Kiewit. In furnishing such material to Kiewit, B. F. Goodrich has at all times had

knowledge of its intended use by Kiewit, and of the manner in which Kiewit has used it in the canal construction. The material was especially made and especially adapted for such use by B. F. Goodrich.

14.

No activities of the defendants, or either of them, other than as described in Findings 11, 12 and 13, are charged by plaintiff to constitute infringement of the patent in suit.

15.

The file wrapper and contents of the patent in suit, and the references cited during the prosecution of the application for patent, are before the Court, being included in Book of Patents and File Wrapper In Support of Defendants' Motion for Summary Judgment, and have been considered by the Court.

16.

The application for the patent in suit as filed contained claims which were all sufficiently broad to embrace any generally cruciform configuration of the insert strip. No cross sectional taper of the vertical element was specified.

17.

The Patent Office rejected all original claims on prior art cited, Carter 2,508,443; Jacobson 2,619,884, and British 646,268 of 1950.

(a) The Carter patent illustrates an elastomeric joint for concrete pavements, the insert embodying a cruciform cross section.

(b) The Jacobson patent discloses an expansion joint employing inserts which have vertical ele-

ments and horizontal waterstops, around which concrete is poured.

(c) The British patent discloses a paving joint utilizing a thermoplastic strip material as a water-stop employed either horizontally or vertically. One form of the strip has a central tubular part. All forms embody ribs, corrugations or projections adapted to key with the concrete.

18.

In response to the rejection referred to in Finding 17, Worson filed an amendment cancelling one claim and amending others.

19.

In response to the amendment referred to in Finding 18, the Patent Office cited additional art, Jacobson 2,025,209 and Fischer 2,540,251, and again rejected the claims.

(a) Jacobson discloses an expansion and contraction joint for pavement, and the insert is tapered both upwardly and downwardly. However, it was cited merely to show a hollow core, as there were no claims in the application at that time defining a taper.

(b) Fischer shows another form of contraction joint for concrete pavements. He combines a vertical cleavage strip, having outer parallel surfaces and a horizontal waterstop in association with the vertical strip. Fischer's purpose is identical to that of Worson. [Col. 2, lines 7-23.] Fischer describes his invention as relating to "contraction joints embedded in concrete pavements as a means whereby cleavage of a section of pavement under in-

ternal stresses of contraction may be restricted to desirable geometrical lines and in rationally distributed vertical planes of subdivision, rather than along irregular lines, at random.” [Col. 1, lines 1-7.]

20.

In response to the rejection noted in Finding 19, Worson’s attorney interviewed the Examiner and then filed an amendment cancelling all the claims and substituting three new claims 13-15. None of these newly submitted claims specified any particular cross section for the vertical element. Worson’s attorney stressed the feature that the vertical bands or elements were defined as being of lesser height than the height of the paving section, and relied on this emphasis.

21.

The Patent Office then cited additional art, Heltzel 2,330,214, and Kelley 2,759,403, and rejected the claims. The Examiner pointed out that both Kelley and Heltzel show fracture bands embedded in a slab with the edges spaced from the upper and lower surfaces of the slab.

(a) Heltzel discloses a joint in concrete pavement, and describes the fracturing of the pavement as a result of its use.

(b) Kelley illustrates a joint in which the fracturing element is cruciform in cross section and opposite surfaces of the elements are parallel.

22.

Worson’s attorney responded to the rejection set forth in Finding 21 by asking for reconsideration, and submitted an extensive written argument urging that the

claims were allowable. Such paper was filed in the Patent Office January 4, 1961. Between that date and April 12, 1961, and prior to a further Office Action, Worson's attorney again interviewed the Examiner, and thereupon filed a supplemental amendment April 14, 1961. This amendment cancelled claims 13-15, and substituted claims 16, 17 and 18, which latter claims are claims 1, 2 and 3 of the patent in suit.

23.

The limitations included in the final set of claims, 16-18, which rendered such claims allowable in the opinion of the Examiner, included the requirement for the first time that the vertically extending paving fracturing band have "its upper portion tapering upwardly for a distance greater than the thickness of said band * * *" and "said band having its lower portion tapering downwardly for a distance greater than the thickness of said band * * *."

24.

(a) In support of the final set of claims, the attorney appended remarks (file wrapper pages 50-51), which included the following language:

"The courtesy of the Examiner at the recent interview is hereby acknowledged.

"At this interview, the desirability of revising the form of the claims so as to patentably distinguish over the prior art was discussed. In accordance with this discussion, claims 13, 14 and 15 have been cancelled and new claims 16, 17 and 18 substituted therefor.

"The new claims specifically recite the applicant's paving fracturing band as having an upper

portion tapering upwardly for a distance greater than the thickness of the band to provide a continuous straight edge below the upper surface of the paving section. Similarly, the lower portion of the band is recited as tapering downwardly for a distance greater than the thickness of the band to provide a continuous straight edge disposed above the lower surface of the paving section. Because of this configuration, the paving section undergoes fracturing in vertical alignment with the upper and lower edges of the band as the paving cures so as to define a weakened plane joint across the paving section.”

(b) Further, in order to support these claims, and after another discussion with the Examiner, Worson inserted in the specification the following language (file wrapper page 58):

“The upper portion of band 12 tapers upwardly for a distance greater than the thickness of the band to provide a continuous upper straight edge while the lower portion of the band tapers downwardly for a distance greater than the thickness of the band to provide a continuous straight edge at the lower end of the band.”

This insert is found in the patent at Column 2, lines 43-49.

25.

In view of this prosecution outlined in Findings 16-24, the patentee has excluded himself from asserting that the use of a fracturing band which is not tapered falls within the scope of his claims. A band which has parallel surfaces is not tapered. No doctrine of equivalents enables him to contend otherwise.

26.

It appears from the appropriate exhibits and description that defendants' structures do not include any band having either its upper portion tapering upwardly or its lower portion tapering downwardly. Consequently, defendants' structures are outside the scope of plaintiff's claims and do not infringe either claim 1 or claim 2.

27.

The claims in suit also call for horizontally extending sealing strips "each being formed with longitudinally extending serration means that are firmly embedded within said paving as said paving cures." The specification states that the sealing strips "are serrated to define longitudinal ribs 19 and are formed at their free ends with an enlarged anchor element 20." [Patent Col. 2, lines 55-57.] The serrations and the anchor elements are independent and separate. [Patent Col. 2, paragraph beginning line 68.] While the serrations are included as claim elements in the patent, the enlarged anchor elements are not mentioned in the claims.

28.

The longitudinally extending serrations were included in original application claims 3, 4, 7, 8 and 12, but no enlarged anchor means. Original claims 6 and 10 included enlarged anchor means but no serrations. Original claim 11 contained both "longitudinally extending serrations" and "enlarged anchor means."

29.

These claims, referred to in Finding 28, were all rejected. In due time they were cancelled, and claims 13-15 substituted. The substituted claims included

“longitudinal serration means” but no enlarged anchor means. The claims were rejected.

30.

In the attorney’s response to the Patent Office, file wrapper 42 et seq., he argued at page 43:

“Assuming, however, that the Kelley device were formed of the resilient material of the British patent, the resulting device would not meet the limitations of the applicant’s claimed combination nor would it be workable. The applicant’s horizontally extending sealing strips are recited as being formed with longitudinally extending serration means. It is absolutely essential that such serration means be provided in order to lock the applicant’s strips to the adjoining paving slabs 60 and 62. Unless these sealing strips are so locked to the adjoining paving slabs, they cannot function as a waterstop, particularly, when the adjoining paving slabs undergo horizontal separation, as indicated in Fig. 4 of the applicant’s drawings.”

These “absolutely essential” longitudinally extending serration means that are firmly embedded within the paving as the paving cures were carried over into claims 16-18 which became claims 1-3 of the patent.

31.

Worson’s attorney further emphasized the importance of these serration means in his argument, file wrapper page 51 in the following language:

“The new claims also recite the applicant’s integral horizontally extending sealing strips 14 and 16 as being formed with longitudinally extending serration means that are firmly embedded within the

paving as the latter cures. This arrangement insures that the sealing strips will restrain the downward flow of water through the joint while relative movement is permitted by the paving sections on either side of the weakened plane joint.”

Nothing was said concerning the enlarged anchor means. They are the marginal enlargements 20. They are not included as elements of the combination claimed in the patent claims.

32.

In view of this prosecution outlined in Findings 28-31, the patentee has excluded himself from asserting that the use of sealing strips which omit longitudinally extending serration means falls within the scope of his claims.

33.

It appears from the appropriate exhibits and description that defendants’ structures do not include any sealing strips which embody longitudinally extending serrations. Consequently, defendants’ structures are outside the scope of plaintiff’s claims, and for such additional reasons do not infringe either claim 1 or claim 2.

34.

Insofar as the affidavits of Francis A. Utecht and Lee Worson filed in opposition to defendants’ motion for summary judgment may appear to conflict with any of the foregoing findings dealing with the file wrapper history, and non-infringement, such affidavits cannot be used to contradict the contents of the file history nor to change the patentee’s position taken therein and therefore present no genuine issues of material facts.

35.

Defendant The B. F. Goodrich Company has the facilities to and does manufacture, and is endeavoring to sell to various contractors other than defendant Kiewit, plastic strip material identical to that sold to Kiewit and for use in paving constructions identical to those charged by plaintiff to be an infringement of the patent in suit. [Uncontradicted Affidavit of William A. Shira, Jr., In Reply to Plaintiff's Opposition to Motion By The B. F. Goodrich Company to Intervene.]

36.

There is a justiciable controversy between plaintiff and defendant B. F. Goodrich properly before this Court, and any uncertainties as to plaintiff's intentions should be resolved by adjudication as to the rights of B. F. Goodrich and its customers and to avoid multiple litigation.

37.

Manufacture by or for the defendant The B. F. Goodrich Company of the insert material exemplified by Interrogatory Exhibits A, B and C, and sale of the same to defendant Peter Kiewit Sons' Co., or any other person, firm or corporation, for utilization in the same manner and for the same construction as utilized by defendant Kiewit, as described in Finding 11 and in the Preface to Interrogatory No. 1, or in any other manner, does not constitute either direct or contributory infringement, or the active inducement of infringement, and defendant B. F. Goodrich and any and all of its customers purchasing such insert material and using it should be held free of any charge of infringement of the patent in suit.

38.

Any conclusion of law hereinafter recited which which should be a finding of fact is hereby adopted as such.

CONCLUSIONS OF LAW

I

This Court has jurisdiction of the cause of action averred in the complaint and the causes of action averred in the counterclaims, and has jurisdiction of the parties.

II

U. S. Letters Patent No. 3,023,681, granted March 6, 1962, for "Combined Weakened Plane Joint Former and Waterstop" is owned by plaintiff, Edoco Technical Products, Inc.

III

Claims 1 and 2 of said Letters Patent were so limited as a result of amendments, admissions and arguments made by the patentee during the prosecution of the application in the United States Patent Office which matured into said Letters Patent, and as required by prior art cited by the Patent Office during said prosecution, that they cannot be construed with sufficient breadth or scope to comprehend any activities of the defendants, or products or structures manufactured or used or sold by said defendants, and consequently, the defendants have not infringed said Letters Patent.

IV

The manufacture and sale by defendant The B. F. Goodrich Company of the plastic insert strips utilized by defendant Peter Kiewit Sons' Co., as set forth in the

Findings of Fact, does not constitute direct or contributory infringement or inducement of infringement of said Letters Patent, and no use of said strip material by any customer of said defendant The B. F. Goodrich Company can constitute infringement of said Letters Patent.

V

Inasmuch as the remaining claim 3 of said Letters Patent No. 3,023,681 was not charged to be infringed, the Court finds it unnecessary to make any conclusion with respect to either the validity or infringement thereof.

VI

Inasmuch as the Court has determined that there are no genuine issues of material fact with respect to the question of non-infringement, and the Court can make final disposition of the case by a decision of non-infringement, summary judgment is called for, and all other issues tendered are thereby moot.

VII

The complaint should be dismissed on the merits and with prejudice to the plaintiff, the counterclaims should be sustained on the ground of non-infringement, and costs should be awarded in favor of defendants.

VIII

Any finding of fact which should be a conclusion of law is hereby adopted as such.

Dated at Los Angeles, California June 30, 1967.

/s/ Jesse W. Curtis

Judge, United States District Court

Presented By: Huebner & Worrel, Herbert A. Huebner, Harlan P. Huebner, Albert L. Gabriel. By /s/ Herbert A. Huebner, Herbert A. Huebner, /s/ Harlan P. Huebner, Harlan P. Huebner, Attorneys for Defendants. William A. Shira, Jr. Of Counsel.

Approved as to Form: Fulwider, Patton, Rieber, Lee & Utecht, By, Attorneys for Plaintiff.

Summary Judgment.

[R 369]

In the United States District Court, Central District of California.

Edoco Technical Products, Inc., Plaintiff, vs. Peter Kiewit Sons' Co., Defendant, and The B. F. Goodrich Company, Intervening Defendant. Civil Action No. 66-1497 JWC.

This cause having come on for hearing on motion for summary judgment filed by defendant Peter Kiewit Sons' Co., and intervening defendant The B. F. Goodrich Company, the showing of plaintiff and defendants having been considered, oral argument having been presented, the Court being advised in the premises, and the Court having determined that there is no genuine issue of material fact on the question of non-infringement and that the defendants are entitled to a judgment of law in accordance with the Findings of Fact and Conclusions of Law, and the Court having ordered that defendants' motion for summary judgment be granted,

IT IS THEREFORE ADJUDGED AND DECREED:

That the complaint and the action is hereby dismissed on the merits with prejudice and that plaintiff take nothing thereby, that the counterclaims of the respective defendants for declaratory judgments be sustained on the ground of non-infringement, and that defendants recover of plaintiff costs in the sum of \$189.90.

There is no just reason for delay in the entry of a final judgment as to the claim for patent infringement made in the complaint of plaintiff, and the claims for relief on the ground of non-infringement made in the counterclaims of defendants, and the Court expressly directs the entry of final judgment accordingly.

Dated at Los Angeles, California, June 30, 1967.

/s/ Jesse W. Curtis

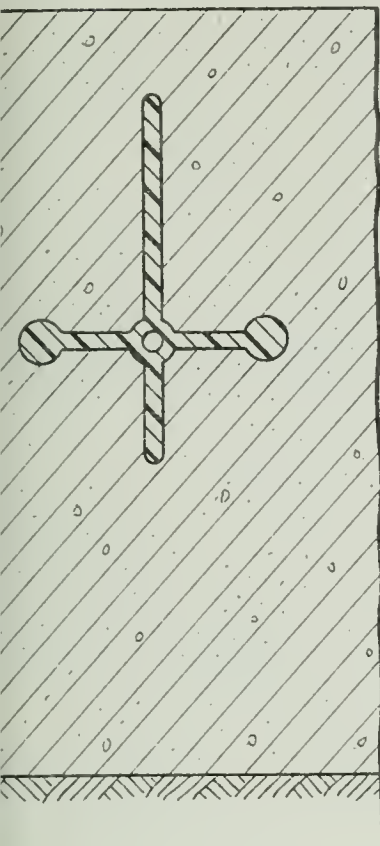
Judge, United States District Court

Presented By: Huebner & Worrel, Herbert A. Huebner, Harlan P. Huebner, Albert L. Gabriel. By /s/ Herbert A. Huebner, Herbert A. Huebner, /s/ Harlan P. Huebner, Harlan P. Huebner, Attorneys for Defendants. William A. Shira, Jr., Of Counsel.

Approved as to Form: Fulwider, Patton, Rieber, Lee & Utecht, By Francis O. Utecht, Attorneys for Plaintiff.



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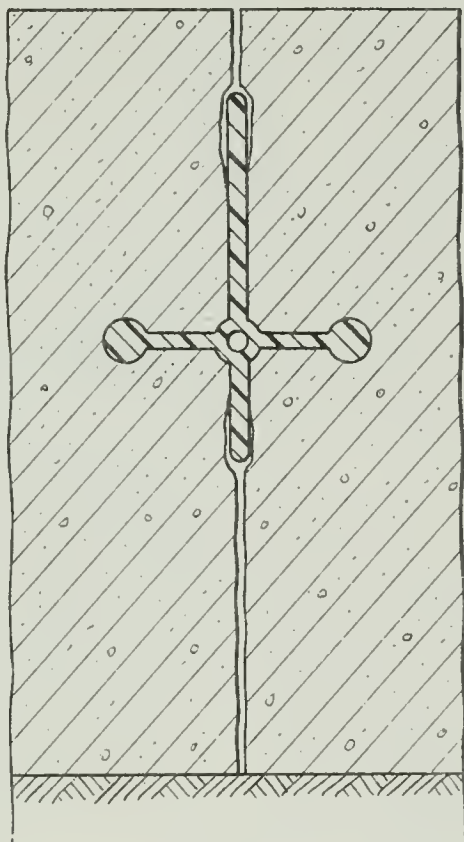


FIG. 3

FRAGMENTARY PLAN VIEW OF CONCRETE LINING
ILLUSTRATING 15' SQUARES DIFINED BY CONTRACTION LINES

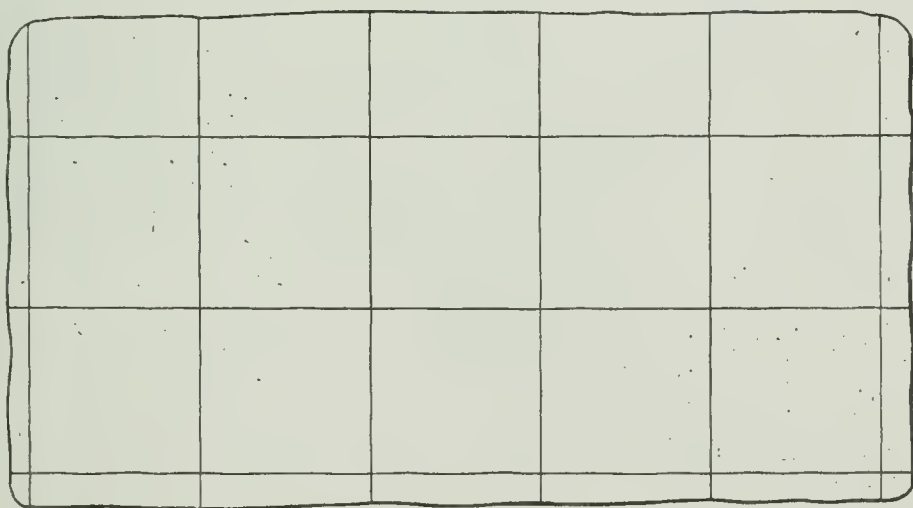


EXHIBIT C

